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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,668	06/19/2001	Donald Edward Helle	DN2001-040	4501

7590                    08/18/2003

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[REDACTED] EXAMINER

LEYSON, JOSEPH S

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1722

DATE MAILED: 08/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	<i>[Signature]</i>
	09/884,668	HELLE ET AL.	
	Examiner Joseph Leyson	Art Unit 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 June 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3 and 5 is/are rejected.
- 7) Claim(s) 2,4 and 6 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 June 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.<br>_____ | 6) <input type="checkbox"/> Other: _____                                     |

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1. Applicant's election with traverse of Group I, apparatus claims 1-6, in Paper No. 4 filed on 17 July 2003 is acknowledged. The traversal is on the ground(s) that the method (Group II) and apparatus (Group I) are so closely related that they are substantially the same invention, and that both the method and apparatus are directed to the concept of providing a narrow strip of electrically conductive rubber in the outer tread of a tire to discharge static electricity generated by a vehicle. This is not found persuasive because, while the method and apparatus as disclosed are closely related and directed to the generic concept of the invention, the method and apparatus as instantly claimed are distinct, each from the other, because the apparatus as claimed can be used to practice another and materially different process such as a process of making multilayer tire tread, wherein all the layers include electrically non-conductive rubber. Note that recitations in apparatus claim 1, such as "for forming an electrically non-conductive rubber outer tread" and "for forming a lower layer of electrically conductive rubber", are not positive apparatus limitations and relate to the intended use of the claimed apparatus. Intended use has been continuously held not to be germane to determining the patentability of the apparatus, In re Finsterwalder, 168 USPQ 530. Purpose to which apparatus is to

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be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. Inclusion of the material worked upon by a structure being claimed does not impart patentability to the claims, *In re Otto et al.*, 136 USPQ 458. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitation of that claimed, *Ex parte Masham*, 2 USPQ 2d 1647. Furthermore, the search and examination of both inventions (method and apparatus) would not be coextensive. The issues raised in the examination of apparatus claims are divergent from those raised in the examination of process claims. While there may be some overlap in the searches of the two inventions, there is no reason to believe that the searches would be identical. Therefore, based on the additional work involved in searching and examining both distinct inventions together, restriction of the distinct inventions is clearly proper.

The requirement is still deemed proper and is therefore made FINAL.

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this

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application by application number and filing date is required.

See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not identify the citizenship of each inventor.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claim 4 and the tapered walls from the upstream side to the downstream side of the chimney block to divert the flow of the outer tread around the chimney block of claim 6, both must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the subject matter of claim 4; and the tapered walls from the upstream side to the downstream side of the chimney block to divert the flow of the outer tread around the chimney block, as recited by claim 6.

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5. Claims 1-6 are objected to because of the following informalities: in claim 1, line 14, "A" should be changed to --a-- for proper idiomatic language. Appropriate correction is required.

6. In claim 2, "said lower under-tread opening" is understood to refer to the "under-tread orifice" of claim 1. The examiner suggests changing "said lower under-tread opening" in claim 2 to --said lower under-tread orifice-- for better readability.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakamura(-119).

Nakamura(-119) teaches a tire tread die, that corresponds to the instant tire tread die, which includes an outer tread passage 10a for forming an electrically non-conductive rubber outer tread (i.e., col. 4, line 63, to col. 5, line 7), a lower under-tread passage 11b for forming a lower layer of

electrically conductive rubber (i.e., col. 4, line 63, to col. 5, line 7), a chimney block 20 mounted in the outer tread passage 10a and extending from an inner surface to an outer surface of the passage (see fig. 5), a chimney block opening 23, 24 extending from one end of the chimney block 20 to an opposite end, an under-tread orifice (the "cutout" in the block 10-2; col. 7, lines 11-14; fig. 5) in the outer tread passage 10a in communication with the lower under-tread passage 11b and with the chimney block opening 23, 24, a slot 25 in a downstream side of the chimney block 20 in communication with the chimney block opening 23, 24 and extending between the one end and the opposite end of the chimney block 20 for communicating a narrow strip of the under-tread layer to the outer tread in the outer tread passage 10a, a final die 6, 6b downstream of the outer tread passage 10a and the lower under-tread passage 11b for receiving the lower under-tread layer and the outer tread with the narrow strip of lower under-tread layer extending from the under-tread to an outer surface of the outer tread. The chimney block 20 having a flow separating protrusion (figs. 5-8) at the upstream side of the chimney block 20, i.e. the upstream end of the block 20 protrudes from its downstream end to enable flow separation. The chimney block opening 23, 24 being a hole through the chimney block 20 into the lower under-tread passage

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11b (fig. 5). Note that a drilled hole is understood to be structurally the same as a generic hole or hole made by a different process. Determination of patentability in "product by process" claims is based on product itself even though such claims are limited and defined by process and thus product in such claim is unpatentable if it is the same or obvious from product of prior art even if prior product was made by different process, In re Thorpe et al., 227 USPQ 964. Patentability of claim to product does not rest merely on difference in method by which product is made, rather it is the product itself which must be new and unobvious, In re Pilkington, 162 USPQ 145.

9. Claims 2, 4 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims, and to overcome objections thereto as mentioned above.

10. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or reasonably suggest the combination of elements defining the tire tread die as recited by instant claim 2, particularly including the lower under-tread passage having the recess at the lower under-tread orifice for guiding the under-tread of electrically conductive rubber into the chimney block opening;

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or the combination of elements defining the tire tread die as recited by instant claim 4, particularly including the chimney block being welded to the upper plate of the outer tread passage to provide the narrow strip of the under-tread layer in the outer tread without smearing; or the combination of elements defining the tire tread die as recited by instant claim 6, particularly including the protrusion having the flow splitting tapered end at the upstream side and tapered walls from the upstream side to the downstream side of the chimney block to divert the flow of the outer tread around the chimney block.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sievers et al.(-376) and Looman et al.(-118) are cited as of interest.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (703) 308-2647. The examiner can normally be reached on M-F(8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*jl*

jl

August 8, 2003

*James Mackey*  
JAMES P. MACKEY  
PRIMARY EXAMINER

*8/8/03*